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Discovery House, Phillip ACT 2606
 PO Box 200, Woden ACT 2606
 Australia
 Phone +61 -2 6283 2999
 Facsimile +61 -2 6283 7999
 Internet <http://www.ipaustralia.gov.au>
 ABN 38 113 072 755

COPY

15 December 2003

PIZZEYS
 GPO Box 1374
 BRISBANE QLD 4001

Your Ref : 11296OIL/WAS/sm

Examiner's first report on patent application no. 2001247301
 by OIL SANDS UNDERGROUND MINING, INC.

Last proposed amendment no. 1

Dear Madam/Sir,

I am replying to the request for examination. I have based this report on the pamphlet and the statement of proposed amendments under S104 of 22 January 2003. I have examined the application and I believe that there are lawful grounds of objection to the application. These grounds of objection are:

1. The specification does not comply with Section 40(4). The claims do not relate to one invention only (or to a group of inventions so linked as to form a single general inventive concept). In assessing whether there is more than one invention claimed, I have given consideration to those features which can be considered to be "special technical features". These are features that potentially distinguish the claimed combination of features from the prior art. Where different claims have different special technical features they define different inventions. I have found claims having different special technical features as follows:
 - (1) Claims 1 - 18 and 29 - 35 are directed to an underground mining method. It is considered that the feature of backfilling comprises a first special technical feature.
 - (2) Claims 19 - 25, 36 and 37 are directed to a tunnelling machine. It is considered that the feature of a hydrocarbon extraction unit and method of extracting bitumen underground comprises a second special technical feature.
 - (3) Claims 26 - 28 and 38 are directed to an underground excavation machine. It is considered that the feature of movable shields comprises a third special technical feature.

Since these groups of claims do not share any of the special technical features identified, a technical relationship between the inventions does not exist. Accordingly the claims do not relate to one invention or to a single inventive concept, a priori.

2. Claim 1 does not define the invention described because it omits the feature "wherein an area of a cross-section of the trailing passage is no more than about 30% of an area of a cross-section of the at least a portion of the excavation before backfilling" which from reading the

specification as a whole and original claim 1 before amendment, appear to be essential to the invention.

3. The invention defined in claims 1 - 38 is not novel and does not involve an inventive step when compared with the disclosure of many patent specifications of which the following are a selection:
 - a) US 4209268 A (FUJITWARA et al) 24 June 1980;
 - b) US 4603909 A (LE JEUNE) 5 August 1986;
 - c) US 4793736 A (THOMPSON et al) 27 December 1988;
 - d) US 4856936 A (HENTSCHEL et al) 15 August 1989;
 - e) US 5211510 A (KIMURA et al) 18 May 1993;
 - f) US 5879057 A (SCHWOEBEL et al) 9 March 1999.
4. Claim 32 is not clear because it is not clear whether claim 32 should depend from claim 26 or claim 29.

You have 21 months from the date of this report to overcome all my objection(s) otherwise your application will lapse. You will need to pay a monthly fee for any response you file after 12 months from the date of this report.

Yours faithfully,

E.J. MARTYN
Examiner of Patents, Section C5
Telephone: (02) 6283 2420